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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,837	08/29/2001	Shawn R. Gettemy	PALM-3651	8549
7590 10/06/2008 WAGNER, MURABITO & HAO LLP Third Floor Two North Market Street San Jose, CA 95113			EXAMINER PIZZALI, JEFFREY J	
			ART UNIT	PAPER NUMBER
			2629	
			MAIL DATE	DELIVERY MODE
			10/06/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/942,837

Applicant(s)

GETTEMY ET AL.

Examiner

Jeff Piziali

Art Unit

2629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 6, 8-11, 13, 15, 17-19, 21, 22, 24, 25 and 29-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 8-11, 13, 15, 17-19, 21, 22, 24, 25 and 29-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 14 July 2008 has been entered.

Drawings

2. The drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the figures.

Specification

3. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-3, 5, 6, 8-11, 13, 15, 17-19, 21, 22, 24, 25, and 29-39 are rejected under 35

U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01.

An omitted structural cooperative relationship results from the claimed subject matter: "***A display assembly for an electronic device comprising***" (in lines 1-2). For example:

It would be unclear to one having ordinary skill in the art what claim element is intended to be the subject of "***comprising***": *A display assembly comprising?* Or rather, *an electronic device comprising?*

7. The term "***substantially parallel***" in claim 1 (in line 13) is a relative term which renders the claim indefinite. The term "***substantially parallel***" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For example:

It would be unclear to one having ordinary skill in the art what definable, measurable range of parallelism encompasses the term "**substantially parallel**." Can *the second portion of the cover and the first side of the display* be off axis by 1 degree? 10 degrees? 44 degrees?

Moreover, could the term "**substantially parallel**" include the meaning "**not parallel**"? Line 4 of the claim includes the expression "*said display surface and said first side are not parallel*." If the display surface and first side are "**substantially parallel**" (but not perfectly parallel), does that mean the display surface and first side are "**not parallel**"?

8. The term "**substantially parallel**" in claim 10 (in line 17) is a relative term which renders the claim indefinite. The term "**substantially parallel**" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For example:

It would be unclear to one having ordinary skill in the art what definable, measurable range of parallelism encompasses the term "**substantially parallel**." Can *the second portion of the cover and the first side of the display* be off axis by 1 degree? 10 degrees? 44 degrees?

Moreover, could the term "**substantially parallel**" include the meaning "**not parallel**"? Line 6 of the claim includes the expression "*said display surface and said first side are not parallel*." If the display surface and first side are "**substantially parallel**" (but not perfectly parallel), does that mean the display surface and first side are "**not parallel**"?

9. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01.

An omitted structural cooperative relationship results from the claimed subject matter: "**A display assembly for an electronic device comprising**" (in lines 1-2). For example:

It would be unclear to one having ordinary skill in the art what claim element is intended to be the subject of "**comprising**": *A display assembly comprising?* Or rather, *an electronic device comprising?*

10. The term "**substantially parallel**" in claim 19 (in line 14) is a relative term which renders the claim indefinite. The term "**substantially parallel**" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For example:

It would be unclear to one having ordinary skill in the art what definable, measurable range of parallelism encompasses the term "**substantially parallel**." Can *the second portion of the cover and the first side of the display* be off axis by 1 degree? 10 degrees? 44 degrees?

Moreover, could the term "**substantially parallel**" include the meaning "**not parallel**"? Line 4 of the claim includes the expression "*said display surface and said first side are not parallel*." If the display surface and first side are "**substantially parallel**" (but not perfectly parallel), does that mean the display surface and first side are "**not parallel**"?

11. The remaining claims are rejected under 35 U.S.C. 112, second paragraph, as being dependent upon rejected base claims.

12. Claims 1-3, 5, 6, 8-11, 13, 15, 17-19, 21, 22, 24, 25, and 29-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

As a courtesy to the Applicant, the examiner has attempted to also make rejections over prior art -- based on the examiner's best guess interpretations of the invention that the Applicant is intending to claim.

However, the indefinite nature of the claimed subject matter naturally hinders the Office's ability to search and examine the application.

Any instantly distinguishing features and subject matter that the Applicant considers to be absent from the cited prior art is more than likely a result of the indefinite nature of the claims.

The Applicant is respectfully requested to correct the indefinite nature of the claims, which should going forward result in a more precise search and examination.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

14. Claims 1, 6, 8, 9, 19, 21, 22, 24, 25, and 31-33, 35, and 36 are rejected under 35 U.S.C. 102(a) as being anticipated by the *Applicants' Admitted Prior Art (AAPA)*.

Regarding claim 1, the *AAPA* discloses a display assembly [*e.g., Fig. 1; 100*] for a portable electronic device comprising:

a display [*e.g., Fig. 1; 140*] comprising a display surface [*e.g., Fig. 1; the top-side of 140*] and a first side [*e.g., Fig. 1; the left-side of 140*], wherein

said display surface and said first side are not parallel;

a digitizer [*e.g., Fig. 1; 120, 130, 170*] disposed above said display and for providing an input to said electronic device in response to a deformation of said digitizer; and

a cover [*e.g., Fig. 1; 105, 110*] disposed above said digitizer and for enabling said deformation of said digitizer in response to a contact with said cover, wherein

a first portion [*e.g., Fig. 1; 110*] of said cover overlaps said display surface, wherein

a second portion [*e.g., Fig. 1; 105*] of said cover overlaps said first side of said display, wherein

said cover comprises at least one bend [*e.g., Fig. 1; 105 bend*] joining said first and second portions and further for enabling said overlapping of said display surface and said first side of said display, and wherein

said second portion of said cover is substantially parallel to said first side of said display (*e.g., see Figs. 1, 2; Page 1, Line 11 - Page 5, Line 21*).

Regarding claim 6, the *AAPA* discloses said cover further comprises a border [*e.g., Fig. 1; 105*] (*e.g., see Page 3, Line 11 - Page 5, Line 11*).

Regarding claim 8, the **AAPA** discloses said digitizer comprises electrical traces [*e.g., Fig. 1; 180*] and circuits [*e.g., Fig. 1; 160*] along a periphery, and wherein said border overlaps said electrical traces and circuits (*e.g., see Fig. 1; Page 3, Line 11 - Page 5, Line 11*).

Regarding claim 9, the **AAPA** discloses said cover comprises indentations [*e.g., Fig. 1; 150, icon sheet*] to indicate button functions (*e.g., see Page 3, Line 11 - Page 5, Line 11*).

Regarding claim 19, this claim is rejected by the reasoning applied in rejecting claim 1; furthermore, the **AAPA** discloses a second cover [*e.g., Fig. 1; 105 on the opposite side of the display assembly, the user's briefcase, the user's purse, the user's pocket*] coupled to said first cover, wherein

said first and second covers enclose said display and said digitizer (*e.g., see Page 1, Line 11 - Page 5, Line 11*).

Regarding claim 21, the **AAPA** discloses said cover is operable to deflect under external pressure and activate said digitizer (*e.g., see Fig. 1; Page 3, Line 11 - Page 5, Line 11*).

Regarding claim 22, this claim is rejected by the reasoning applied in rejecting claim 6.

Regarding claim 24, this claim is rejected by the reasoning applied in rejecting claim 8.

Regarding claim 25, this claim is rejected by the reasoning applied in rejecting claim 9.

Regarding claim 31, the *AAPA* discloses said digitizer further comprises a plurality of electrodes [e.g., Fig. 1; 160] and traces [e.g., Fig. 1; 180] operable to register a point of contact when said conductor makes contact with said digitizing element (e.g., Page 3, Line 11 - Page 5, Line 11).

Regarding claim 32, the *AAPA* discloses said first cover comprises at least one transparent portion [e.g., Fig. 1; 110] (e.g., see Page 1, Line 11 - Page 5, Line 11).

Regarding claim 33, the *AAPA* discloses said digitizer comprises a resistive digitizer [e.g., Fig. 1; 130] (e.g., see Page 1, Line 11 - Page 5, Line 11).

Regarding claim 35, this claim is rejected by the reasoning applied in rejecting claim 32.

Regarding claim 36, this claim is rejected by the reasoning applied in rejecting claim 33.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 2, 5, 10, 13, 15, 17, 18, 30, 34, 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over the *Applicants' Admitted Prior Art (AAPA)* in view of *Conroy et al (US 5,686,705 A)*.

Regarding claim 2, the *AAPA* discloses said digitizer comprises a conductive film made of indium tin oxide [e.g., *Fig. 1; 120*] disposed above a digitizing element [e.g., *Fig. 1; 130*] (e.g., see *Fig. 1; Page 3, Line 11 - Page 5, Line 11*).

However, *Conroy* discloses substituting conductive digitizer wires with a conductive polymer composite, such as conductive plastic (e.g., see *Column 3, Lines 9-30, Column 4, Lines 21-32, Column 5, Line 55 - Column 6, Line 10, and Column 8, Lines 37-40*).

The *AAPA* and *Conroy* are analogous art, because they are from the shared field of manufacturing electronic touch panel devices. Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to use *Conroy's* conductive polymer in place of the *AAPA's* conductive film, so as to provide a rugged and reliable electronic device.

Regarding claim 5, the *AAPA* discloses said digitizer further comprises a plurality of electrodes [e.g., *Fig. 1; 160*] and traces [e.g., *Fig. 1; 180*] operable to register a point of contact when said conductor makes contact with said digitizing element (e.g., *Page 3, Line 11 - Page 5, Line 11*).

Regarding claim 10, this claim is rejected by the reasoning applied in rejecting claim 1; furthermore, *Conroy* discloses a portable electronic device comprising:

a processor [*e.g.*, *Fig. 4; 142*]; and
a memory [*e.g.*, *Fig. 4; 145, 147*] coupled to said processor (*e.g.*, *see Column 11, Lines 11-40*).

Regarding claim 13, this claim is rejected by the reasoning applied in rejecting claims 2 and 5; furthermore, the *AAPA* discloses said cover is operable to deflect under external pressure and cause said conductive film to contact said digitizing element and activate said digitizer (*e.g.*, *see Fig. 1; Page 3, Line 11 - Page 5, Line 11*).

Regarding claim 15, this claim is rejected by the reasoning applied in rejecting claim 6.

Regarding claim 17, this claim is rejected by the reasoning applied in rejecting claim 8.

Regarding claim 18, this claim is rejected by the reasoning applied in rejecting claim 9.

Regarding claim 30, this claim is rejected by the reasoning applied in rejecting claims 2, 5, and 13.

Regarding claim 34, this claim is rejected by the reasoning applied in rejecting claim 5.

Regarding claim 37, this claim is rejected by the reasoning applied in rejecting claim 19.

Regarding claim 38, this claim is rejected by the reasoning applied in rejecting claim 32.

Regarding claim 39, this claim is rejected by the reasoning applied in rejecting claim 33.

17. Claims 3 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over the *Applicants' Admitted Prior Art (AAPA)* in view of *Suzuki (US 6,529,188 B1)*.

Regarding claim 3, the *AAPA* discloses said cover further comprises a flexible film [e.g., *Fig. 1; 110*] and a supporting structure [e.g., *Fig. 1; 105*] coupled to said flexible film (e.g., *Page 3, Line 11 - Page 5, Line 11*).

Suzuki discloses a cover [e.g., *Fig. 1A; 4A*] disposed above a digitizer [e.g., *Fig. 1A; 11 and 12*] further comprises a flexible thermoplastic film [e.g., *Fig. 1A; 4A*] and a supporting structure [e.g., *Fig. 1A; 4B*] coupled to said flexible thermoplastic film (e.g., see Column 10, Lines 46-52).

The *AAPA* and *Suzuki* are analogous art, because they are from the shared field of manufacturing electronic touch panel devices. Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to use *Suzuki's* flexible thermoplastic film cover in place of the *AAPA's* flexible film cover, so as to provide a soft, transparent, and protective cover with a commonly available manufacturing material.

Regarding claim 29, this claim is rejected by the reasoning applied in rejecting claim 3.

18. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over the *Applicants' Admitted Prior Art (AAPA)* and *Conroy et al (US 5,686,705 A)* as applied to claim 10 above, and further in view of *Suzuki (US 6,529,188 B1)*.

Regarding claim 11, this claim is rejected by the reasoning applied in rejecting claim 3.

Response to Arguments

19. Applicant's arguments filed 14 July 2008 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claims 1-3, 5, 6, 8-11, 13, 15, 17-19, 21, 22, 24, 25, and 29-39 have been considered but are moot in view of the new grounds of rejection.

By such reasoning, rejection of the claims is deemed necessary, proper, and thereby maintained at this time.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Piziali whose telephone number is (571) 272-7678. The examiner can normally be reached on Monday - Friday (6:30AM - 3PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on (571) 272-7681. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeff Piziali/
Primary Examiner, Art Unit 2629
26 September 2008